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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,405	01/05/2005	Johann Bonn	263493US0PCT	9920

22850 7590 01/26/2010
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EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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01/26/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHANN BONN, KLAUS LORENZ, JORG WEHRLE, and
MANFRED MATZ

Appeal 2009-009443
Application 10/519,405
Technology Center 1700

Decided: January 22, 2010

Before CATHERINE Q. TIMM, MICHAEL P. COLAIANNI, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

ROBERTSON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of pending claims 1, 3-9, 16, and 18-22. (Appeal Brief filed November 21, 2008, hereinafter "App. Br.," 2). We have jurisdiction pursuant to 35 U.S.C. § 6(b).¹

We REVERSE.

Appellants describe an antifoam and/or deaerator based on an oil-in-water dispersion. (Spec. 1, ll. 5-13). Claim 1 is representative and recites:

1. An antifoam and/or deaerator based on an oil-in-water dispersion comprising an oil phase of at least one hydrophobic compound and an aqueous phase which comprises at least one stabilizer, water and, optionally, a thickener, wherein the oil-in-water dispersion comprises a combination of
 - component (i) at least one polyglyceryl ester which is obtained by at least 20% esterification of polyglycerol with a carboxylic acid of 12 to 36 carbon atoms
 - and
 - component (ii) at least one bisamide of ethylenediamine and carboxylic acids of 10 to 36 carbon atoms,wherein the hydrophobic compound is selected from the group consisting of the alcohols of at least 12 carbon atoms, mono-, di- and triglycerides of fatty acids, fatty acid esters of carboxylic acids of at least 12 carbon atoms and monohydric to tetrahydric alcohols of 1 to 24 carbon atoms, 3-thiaalkan-1-ols, 3-thiaoxoalkan-1-ols, 3-thiadioxoalkanols, esters of the thiaalkane compounds and mixtures thereof, and
wherein the dispersion excludes fatty acids of 12 to 26 carbon atoms and alkoxylated fatty alcohols.

¹ Oral arguments were heard in this Appeal on January 12, 2010.

The Examiner rejected claims 1, 3-9, 16, and 18-22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.²

The Examiner found that Appellants' Specification does not describe the recitation "wherein the dispersion excludes fatty acids of 12 to 26 carbon atoms" with respect to components (i) and (ii). (Ans. 3 and 4). The Examiner's position is that because components (i) and (ii) are in product-by-process format and produced by equilibrium reactions reacting carboxylic acids of 12 to 36 carbon atoms and 10 to 36 carbon atoms respectively, some fatty acids would be present in the composition, which overlap the exclusionary range recited in the claims. (Ans. 4-7). The Examiner found that because Appellants do not disclose any techniques by which to purify the products or separate un-reacted fatty acid, Appellants reliance on *In re Johnson* 558 F.2d 1008 (CCPA 1977) is misplaced as providing support for the negative limitations in the claims. (Ans. 5-7).

Appellants contend that the Specification discloses the particular species of hydrophobic compound excluded from the claims and that the Examiner ignores the claim limitations that require component (i) to be an ester and component (ii) to be an amide. (App. Br. 4 and 5).

² The Examiner withdrew the rejection of claims 1, 3-9, 16, and 18-22 under 35 U.S.C. § 112, second paragraph as indefinite in the Answer. (Examiner's Answer entered December 26, 2008, hereinafter "Ans.," 2).

ISSUE

Have Appellants shown that the Examiner reversibly erred in finding that the recitation “wherein the dispersion excludes fatty acids of 12 to 26 carbon atoms” lacks written description support in the Specification?

FINDINGS OF FACT

The record supports the following Findings of Fact (FF) by a preponderance of the evidence.

1. Appellants’ Specification discloses that the “*oil phase* contains at least one compound from the group consisting of . . . fatty acids of 12 to 26 carbon atoms. . . .” (Spec. 3, ll. 23-35 (emphasis added)).
2. Appellants’ Specification discloses: “[a]ccording to the invention, the antifoams and/or deaerators contain, *in the hydrophobic phase*, combinations of (i) at least one polyglyceryl ester . . . and (ii) at least one bisamide” (Spec. 7, ll. 25-33 (emphasis added)).
3. Appellants’ Specification discloses in Example 1, a polyglycerol ester prepared by 75% esterification of a polyglycerol mixture with a C₁₂ to C₂₆ fatty acid mixture and ethylenebisstearamide. (Spec. 15, ll. 1-15, Example 1).

PRINCIPLES OF LAW

To satisfy the written description requirement, a patent applicant must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991) (emphasis omitted).

The mere absence of literal support for a claim limitation “does not, in and

of itself, establish a *prima facie* case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112.” *Ex parte Parks*, 30 USPQ2d 1234, 1236 (BPAI 1993) (citations omitted).

“[The] specification, having described the whole, necessarily described the part remaining.” *In re Johnson*, 558 F.2d 1008, 1019 (CCPA 1977).

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirement of s [sic] 112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute.

Id.

ANALYSIS AND CONCLUSION

After careful review of both the Appellants’ and the Examiner’s positions, we agree with Appellants, that the Specification provides sufficient support for the recitation “wherein the dispersion excludes fatty acids of 12 to 26 carbon atoms” in the claims. The Specification discloses that the oil phase, which includes components (i) and (ii), contains fatty acids of 12 to 26 carbon atoms, thus providing the basis for exclusion of such acids from the oil phase and the dispersion recited in the claims. (FF 1 and 2).

We fully appreciate the Examiner’s distinction between by-products of the reactions used to produce the ester of component (i) and the bisamide of component (ii), and hydrophobic compounds including fatty acids having 12 to 26 carbon atoms. However, the claims expressly require esters and

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bisamides in components (i) and (ii), respectively. The Examiner has not provided sufficient evidence to support the position that components (i) and (ii) would contain residual amounts of fatty acids such that *In re Johnson* would not be applicable in excluding such acids from the claims. Accordingly, we do not sustain the Examiner's rejection.

ORDER

We reverse the Examiner's decision rejecting claims 1, 3-9, 16, and 18-22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

REVERSED

KMF

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